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EXAMINER

SANDERS, STEPHEN

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/525,138
Filing Date: February 16, 2005
Appellant(s): HE ET AL.

Dicran Halajian
Reg. No. 39,703
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 28, 2010 appealing from the Office action mailed September 8, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The examiner has no comment on the appellant's statement of the status of claims.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(7) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4-6, 8-15, and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al, (U. S. Patent Number WO 01/90860 A2), hereinafter Schwartz, in view of Collart (U.S. Patent Number 6,405,203).

As to claim 1, the following is taught: "A communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of:

extracting memory medium properties from the memory medium inserted in the device, sending said memory medium properties to the remote unit, authenticating the memory medium by comparing said memory medium properties with corresponding

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properties of a corresponding memory medium legally produced by a provider, before sending the additional data to the device, and determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; page 4, lines 4-8; page 5, lines 20-22; page 14; See claims starting page 16; also see Response to Arguments);

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 1, but fails to teach: region codes and their usage. However, Collart teaches “wherein the memory medium properties include a region code of the memory medium” (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart’s teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include region codes and their usage in determining the memory medium’s authenticity. Although these specifics are not recited by Schwartz, one would be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 2, the following is taught: “The communication method as claimed in claim 1, wherein the memory medium properties are written in a control data zone of the

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memory medium.” (Schwartz teaches: Abstract, Detailed Description of the Preferred Embodiment: page 4, lines 4-8; page 5, lines 6-11; See claims starting page 16).

As to claim 4, the following is taught: “The communication method as claimed in claim 1, wherein the remote unit is able to send different types of additional data as a function of the memory medium properties.” (Schwartz teaches: Detailed Description of the Preferred Embodiment: page 13, line 27 to page 14, line 2; See claims starting page 16).

As to claim 5, the following is taught: “A communication system comprising a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said device and the remote unit communicating via a network, wherein the remote unit is able to retrieve memory medium properties from the memory medium inserted in the device, to authenticate said memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to said device and to determine that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium.” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; page 4, lines 4-8; page 5, lines 20-22; page 14; See claims starting page 16; also see Response to Arguments);

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 5, but fails to teach: region codes and their usage. However, Collart teaches “wherein the memory medium properties include a region code of the memory medium” (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart's teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include region codes and their usage in determining the memory medium's authenticity. Although these specifics are not recited by Schwartz, one would be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 6, the following is taught: “A remote unit for communicating with a device able to read a memory medium, the remote unit comprising additional data for the memory medium, means for retrieving memory medium properties from the memory medium inserted in the device, means for authenticating said memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to said device and means for determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory includes identical content for rendering as the corresponding memory medium” (Schwartz teaches: Abstract; Summary of

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Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 5, lines 6-11; page 5, lines 20-22; page 14; See claims starting page 16; also see Response to Arguments).

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 6, but fails to teach: region codes and their usage. However, Collart teaches “wherein the memory medium properties include a region code of the memory medium” (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart’s teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include region codes and their usage in determining the memory medium’s authenticity. Although these specifics are not recited by Schwartz, one would be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 8, the following is taught: “A computer readable medium embodying a computer program comprising program instructions for implementing, when said program is executed by a processor, a communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of: extracting memory medium properties from the memory medium inserted in the device, sending said memory medium properties to the remote unit, and determining that the memory

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medium is illegally produced when the memory medium properties are different from corresponding properties of a corresponding memory medium legally produced by a provider even if the memory medium includes identical content for rendering as the corresponding memory medium.” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 3, lines 1-10; page 5, lines 9-11; page 5 line 26 to page 12, line 26; page 14; See claims starting page 16; also see Response to Arguments).

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 8, but fails to teach: region codes and their usage. However, Collart teaches “wherein the memory medium properties include a region code of the memory medium” (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart’s teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include region codes and their usage in determining the memory medium’s authenticity. Although these specifics are not recited by Schwartz, one would be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 9, the following is taught: “A computer readable medium embodying a computer program comprising program instructions for implementing, when said program is executed by a processor, a communication method via a network between a

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device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of: retrieving memory medium properties from the memory medium inserted in the device, authenticating the memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to the device, and determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium.” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 5, lines 6-11; page 5, lines 20-22; page 5, line 26 to page 12, line 26; page 14; See claims starting page 16; also see Response to Arguments).

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 9, but fails to teach: region codes and their usage. However, Collart teaches “wherein the memory medium properties include a region code of the memory medium” (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart’s teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include region codes and their usage in determining the memory medium’s authenticity. Although these specifics are not recited by Schwartz, one would

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be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 10, the following is taught: “The communication method of claim 1, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 11, the following is taught: “The communication method of claim 1, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 12, the following is taught: “The communication system of claim 5, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 13, the following is taught: “The communication system of claim 5, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 14, the following is taught: “The remote unit of claim 6, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 15, the following is taught: “The remote unit of claim 6, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 20, the following is taught: “The communication method of claim 1, wherein the additional data includes advertisement depending on the region code” (advertising; Collart: Abstract; Figures 8, 9; column 4, lines 35-38; column 16, lines 54-57; column 20, line 26; column 21, line 16).

As to claim 21, the following is taught: “The communication method of claim 1, further comprising the act of allowing recording of the additional data if the authenticating act is successful” (Schwartz: Abstract; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21).

As to claim 22, the following is taught: "The communication method of claim 1, further comprising the act of allowing access to the additional data only while the memory medium is being played in the device" (Schwartz: Abstract; page 1, line 19 to page 2, line 17; page 5, lines 20-27; page 12, line 16).

As to claim 23, the following is taught: "The communication system of claim 5, wherein the additional data includes advertisement depending on the region code" (advertising; Collart: Abstract; Figures 8, 9; column 4, lines 35-38; column 16, lines 54-57; column 20, line 26; column 21, line 16).

As to claim 24, the following is taught: "The remote unit of claim 6, wherein the additional data includes advertisement depending on the region code" (advertising; Collart: Abstract; Figures 8, 9; column 4, lines 35-38; column 16, lines 54-57; column 20, line 26; column 21, line 16).

As to claim 25, the following is taught: "The communication system of claim 5, wherein the region code is stored in a secondly content provide, information of a control data zone of a lead-in area of the memory medium; the control data zone further including physical format information; the physical format information including book type, disc size, disc structure, and burst cutting area (BCA) descriptor (genre/type BCA information; Collart: column 21, lines 52-58); wherein the disc structure includes a number of layers of the disc, a layer type and a track path (structural arrangement;

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(Schwartz: page 2, lines 12-17), and the secondly content provider information further include copyright (copyright protection; Collart: column 32, lines 41-48) information.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al, (U. S. Patent Number WO 01/90860 A2), hereinafter Schwartz, in view of Collart (U.S. Patent Number 6,405,203), in further view of Valente et al (U.S. Publication Number 2003/0110192 A1), hereinafter Valente.

As to claim 18, the following is taught: "The communication method of claim 1 (See claim 1 above).

As to the above parenthesized references, Schwartz, and Collart teach the referenced elements of claim 18, but fails to teach: "blacklisting the device if the remote unit receives a number of requests higher than a predetermined threshold from the device containing a non-authenticated memory medium". However, Valente teaches blacklisting a device after it exceeds a number of attempts of "illegal" operations and renders device incapable of conducting further activities (Valente: page 6, paragraph [0070]). In view of Valente's teachings regarding blacklisting techniques, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made

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to specifically include blacklisting techniques in determining device authentication.

Although these specifics are not recited by Schwartz, and Collart, one would be motivated to use any and all blacklisting techniques in order to provide for better and faster authentication management, and prevent illegal copying of recorded data.

(8) Response to Argument

Claims 1-2, 4-6, 8-15 and 20-25 are said to be unpatentable under 35 U.S.C.

§103(a) over Schwartz in view of Collart.

Applicant correctly points out in their Argument that Schwartz generates a unique identifier to compare it to the identifier on the audio CD in order to verify authorized use. The Applicant's argument continues and states that Schwartz does not disclose or suggest the specific use of a "region code" for this verification and that Collart is cited in an attempt to remedy the deficiencies in Schwartz. Applicant argues that because Collart focuses on using region codes to track pirated DVDs and trace them back to a retailer/distributor, that Collart does not remedy the deficiencies in Schwartz. Examiner disagrees. In response to Applicant's argument that Collart does not remedy the deficiencies in Schwartz, Examiner notes that although Collart discusses the use of region codes for purposes of tracking distribution location, this does not limit Collart's teachings of the memory medium properties including a region code for purposes of authenticity. In fact, Collart (column 19, lines 5-25) discusses BCA (Burst Cutting Area on disc) along with region code (column 19, lines 5-25) and on BCA generally on 11 other pages of their specification, along with 16 separate Figures (Collart: Figures 6, 8-9

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and 11-22). (Note: BCA, the burst cutting area refers to the circular area near the center of a disc which include information such as ID codes, manufacturing information, and serial numbers; see Collart: column 6, lines 3-9).

Additionally, although Schwartz does not directly disclose or suggest the use of a "region code" as a unique identifying indicia, Schwartz indirectly does so by stating (Schwartz: specification - page 14) "Those skilled in the art will appreciate that although these are examples of multimedia data, other types of corresponding data other than multimedia (e.g., program codes, encrypted data, etc.) may also be utilized in accordance with a preferred embodiment of the present invention. The unique identifying indicia is a unique identifier derived from information stored on the physical removable media itself. In a preferred embodiment, the unique identifier is based on the "Red Book" audio standard, well-known in the electronic recording arts."

Further, the Red Book audio specifications state that the International Standard Recording Code (ISRC), which represents the country region code, should be included on the disc. Note: The first edition of the Red Book was released in 1980 by Philips and Sony; it was adopted by the Digital Audio Disc Committee and ratified as EIC 60908 (published in 1987). The second edition of IEC 60908 was published in 1999.

Hence, Examiner believes it is clear that Claims 1-2, 4-6, 8-15 and 20-25 are said to be unpatentable under 35 U.S.C. §103(a) over Schwartz in view of Collart.

**Claim 18 is said to be unpatentable under 35 U.S.C. §103(a) over Schwartz
in view of Collart and Valente.**

In response to Applicant's argument regarding claim 18 said to be unpatentable under 35 U.S.C. §103(a) over Schwartz in view of Collart and Valente, and Applicant's request to allow claim 18 at least based on its dependence indirectly from independent claim 1, please see above response to argument regarding Claims 1-2, 4-6, 8-15 and 20-25, which include all the independent claims including claim 1.

Hence, Examiner believes it is clear that Claim 18 is said to be unpatentable under 35 U.S.C. §103(a) over Schwartz in view of Collart and Valente.

(9) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Stephen Sanders/
Examiner, Art Unit 2434

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